

REMARKS/ARGUMENTS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 17-36 are pending in the present application. Claims 17, 26, and 27 are amended. Claims 33-36 are newly added. Support for the amendment to Claim 17 can be found in the specification as published at least in paragraph [0058] and in Figure 1. Support for the amendment to Claim 26 can be found in the specification as published at least in paragraph [0062]. Support for the amendment to Claim 27 can be found in the specification as published at least in paragraph [0064]. Support for newly added Claims 33-36 can be found in the specification as published at least in paragraph [0058]. Thus, no new matter is added.

In the outstanding Office Action, Claim 26 was objected to for informalities. Claims 17-29 and 32 were rejected under 35 U.S.C. § 102(b) as anticipated by Lee (U.S. Patent No. 3,971,320). Claims 30-31 were rejected under 35 U.S.C. § 103(a) as unpatentable over Lee.

In response to the objection to Claim 26, Claim 26 is amended to correct the noted informalities and to better comply with U.S. practice.

Applicants respectfully traverse the rejection of Claims 17-24, 27-29 and 32 under 35 U.S.C. § 102(b) as anticipated by Lee.

Amended independent Claim 17, recites, in part:

plastic members arranged to contact the respective electrode pins so that the plastic members surround a part of the respective electrode pins circumferentially, and

wherein through holes for the respective electrode pins to pass through the holder are formed in the holder, and the electrode pins are fixed to the holes via the plastic members, each hole including a diameter-reduction portion at a part thereof,

wherein the plastic members are sandwiched between a part of the holder corresponding to the diameter-reduction portion and the respective electrode pins in the radial direction of the respective electrode pins.

Thus, the metal holder is disposed outside of the plastic members. One non-limiting example of the above-noted arrangement is shown in Figure 1 of the original disclosure.

Turning now to the cited art, Lee describes a metal holder with a plastic member (10) disposed **outside** of the metal holder (12) as shown in Figure 1 of Lee.

In contrast, the invention recited in amended independent Claim 17 recites that the metal holder is disposed outside of the plastic members.

Furthermore, amended independent Claim 17 recites that the plastic members are sandwiched between a part of the holder corresponding to the diameter-reduction portion and the respective electrode pins in the radial direction of the respective electrode pins.

In contrast, Lee fails to disclose such a positional relationship among the three components. Instead, Lee does not disclose a holder with a diameter-reduction portion. Furthermore, the plastic member in Lee is on the outside of the holder. Accordingly, the plastic member is not sandwiched between the holder and the pin. Rather, the plastic member is the outermost component in Lee.

In addition, amended independent Claim 17 recites the metal holder having **through holes** which **penetrate therethrough**. Lee does not have such through holes. Furthermore, amended independent Claim 17 recites a diameter-reduction portion of the hole through the metal holder. Lee fails to disclose such a diameter-reduction portion.

Accordingly, Applicants respectfully submit that Claim 17 patentably defines over Lee. Therefore, Applicants respectfully request the rejection under 35 U.S.C. § 102(b) of Claim 17, and Claims 18-24, 27-29, and 32, which depend from Claim 17, be withdrawn.

In addition, Applicants respectfully traverse the rejection of Claims 25 and 26 under 35 U.S.C. § 102(b) as anticipated by Lee.

Independent Claims 25 and 26, recite, in part:

the metal holder is pressed at portions thereof around both opening portions of the holes in a depth direction thereof so that the plastic members can be partly reduced in diameter to fix the electrode pins.

Lee does not disclose the above-noted feature.

The outstanding Office Action states, “[R]egarding claims 25 and 26, in light of the structure disclosed by Lee the method would have been **inherent**, since it is the normal and logical manner in which the device can be made.”¹

Applicants respectfully submit that inherency has not been established in the outstanding Office Action. “The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” MPEP § 2112, In re Rijckaert, 9 F.3d 1531, 1534, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993). Moreover:

to establish inherency, the extrinsic evidence “must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.”

In re Robertson, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999).

As set forth in MPEP § 2112, “in relying upon the theory of inherency, the Examiner **must** provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” (emphasis added). Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

¹ See outstanding Office Action at page 3 (emphasis added).

In effect, the outstanding Office Action takes Official Notice that the above-noted features recited in Claims 25 and 26 are obvious but does not provide any documentation to support this assertion.

Official Notice should be taken only for facts readily available, and documentation should be provided for Official Notice when Official Notice is asserted to provide entire features of claims. Accordingly, Applicants respectfully request that the Examiner provide documentation such as an affidavit or declaration in the next Official Action should Official Notice be maintained in asserting that the recited method of producing a metal holder with electrode pins as recited in independent Claims 25 and 26 is well-known.

Furthermore, Applicants respectfully submit that the recited method of producing a metal holder with electrode pins is not well known in the art. It is unreasonable to substitute Official Notice for documentary evidence of the recited features. In other words, such expansion of reference teachings using unfounded assumptions and/or speculation cannot be substituted for actual reference teachings. *See In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967) (“The Patent Office has the initial duty of supplying the factual basis for its rejection. It may not, because it may doubt that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis.”). Thus, withdrawal of this rejection and of the Official Notice taken in the outstanding Office Action is respectfully requested.

Accordingly, Applicants respectfully request the rejection under 35 U.S.C. § 102(b) of Claims 25 and 26 be withdrawn for the above-noted reasons.

In addition, Applicants respectfully traverse the rejection of Claims 30-31 under 35 U.S.C. § 103(a) as unpatentable over Lee.

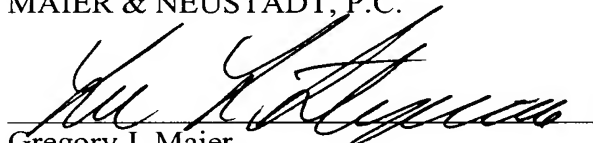
As discussed above, the invention recited in amended independent Claim 17 patentably defines over Lee. Thus, Lee does not suggest the invention recited in amended independent Claim 17 or Claims 30-31 depending therefrom.

Newly added dependent Claims 33-36 recite substantially similar features to those discussed above regarding amended independent Claim 17 in method format, and patentably distinguish over Lee for at least the same reasons as amended independent Claim 17 does.

Consequently, in light of the above discussion and in view of the present amendment, the present application is believed to be in condition for allowance and an early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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